

REMARKS

Applicants thank the Examiner for removing the prior rejections of the pending claims in this application. By the foregoing amendment, claim 1 has been amended to further clarify the claimed invention.

In the Office Action, claims 1-13, 17-29 and 33-45, 49 and 50 are rejected on new grounds under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,263,162 to Bush et al. (hereinafter “Bush”). The remaining claims are rejected as inherent in view of Bush. Applicants respectfully traverse the rejections of record.

Independent claim 1 as amended is directed to a method for generating identification data, comprising the steps of:

providing an ATM PIN related to a first transaction type that is an ATM transaction; and

performing a cryptographic operation upon the ATM PIN, thereby generating a non-ATM electronic commerce PIN based on said ATM PIN for use in a second transaction type that is a non-ATM financial transaction.

Bush is directed to a portable personal identification card (“PIN card”) which allows a holder to enter a PIN code into his PIN card at a location remote from an authorization terminal. *See Bush, Abstract.* One of the primary examples discussed throughout Bush is a restaurant scenario wherein a customer does not have physical access to an ATM terminal. *See, e.g., Bush, col. 1, lines 40-47; col. 2, lines 21-42.* To solve the alleged problem in the prior art, Bush utilizes a PIN card with an on-board keypad. *See, e.g., Bush, col. 3, lines 17-*

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More specifically, Bush is directed to a system described as follows:

The authorization terminal scans the PIN Card for an account number which is sent off to a central computer. The central computer sends back a pseudo-random number which is used by the card to produce a CGIPIN. The central computer also produces a CGIPIN using a duplicate process. The authorization terminal sends the CGIPIN to the central computer. If the CGIPINs match, authorization is granted.

Bush, col. 2, lines 26-34.

In great contrast, the present claimed invention is directed to financial transactions and more particularly to a system which utilizes an electronic commerce PIN which is cryptographically derived from an ATM PIN. In this manner, an unauthorized party would be prevented from deducing the ATM PIN from the e-commerce PIN, which e-commerce PIN is input by the user in the course of performing another separate electronic transaction which is *not* an ATM transaction. *See Summary of the Invention, pp. 3-4.*

In the Office Action, the Examiner equates the claim's use of the term "ATM PIN" with "PIN" (as used in Bush) and the claimed non-ATM electronic commerce PIN with "CGIPIN" (as used in Bush). The instant claimed invention, however, concerns the use of PINs for one transaction type (for ATMs) and the use of a second, cryptographically-generated PIN for a second different transaction type. Although Bush may be directed to a system which generates a "CGIPIN" based in part on a PIN, it does so only in connection with the authorization process of a *single* transaction which the user initiates by inserting his or her PIN, not the CGIPIN. In contrast, the invention of claim 1 requires use of not the PIN but the e-commerce PIN cryptographically generated from the PIN. As a result, the e-commerce PIN used is different from the ATM PIN, and an unauthorized party would be prevented from deducing the ATM PIN from the e-commerce PIN. However, an authorized party knowing a secret key may recover the ATM PIN from the e-commerce PIN (e.g., the e-commerce PIN is a reversible encrypted version of the ATM PIN). Once recovered, the ATM PIN is transmitted to the issuer so that the issuer can use its current PIN verification methodology to verify the inputted PIN.

In the Office Action, the Examiner seemingly equates the *first transaction type* of the present invention with a "perform encryption" step of Bush, and the *second transaction type*

of the claimed invention with the “comparing and matches” of Bush. *See Office Action, pp. 2-3.* This analysis is flawed for several reasons. First, the PIN of Bush is a particular type of PIN which is entered into the on-board keypad of a specialized PIN card. This is *not* described as an ATM PIN as is recited in the claims of the present invention.

Moreover, as is clear from the claims and specification of the present application, the first and second “transaction types” of the present invention clearly relate to separate *financial or payment transactions.*

For example, claim 1 recites “providing an ATM PIN related to a first transaction type *that is an ATM transaction.*” The second transaction is referred to as a second transaction type *that is a non-ATM financial transaction,* thus establishing that the claims refer to payment transactions. The Examiner, however, fails to identify two separate financial transaction types disclosed in the Bush reference and Applicants respectfully submit that there are none. Indeed, Bush utilizes a specialized PIN card *in conjunction with a normal credit card to facilitate a single type of transaction.* In short, Applicants submit that Bush does not teach, disclose or suggest “providing an ATM PIN related to a first transaction type *that is an ATM transaction*” and “generating a non-ATM electronic commerce PIN based on said ATM PIN for use in a *second transaction type that is a non-ATM financial transaction.*”

Regarding claims 6, 7, 8, 9, 10, 11, 12, 13, the Examiner looks to the Konheim reference as a basis for the rejections. However, the Examiner clearly states on page 2 of the Office Action that the rejections of these claims are pursuant to 35 U.S.C. § 102(b) in view of the Bush reference and, accordingly, combination with any other reference, Applicants submit, would be improper. Indeed, as stated by the Federal Circuit, “[w]hen more than one reference is required to establish unpatentability of the claimed invention anticipation under §

102 cannot be found.” *Continental Can Company USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ2d 1746 (Fed. Cir. 1991).

Even if properly considered, Konheim fails to disclose or suggest numerous limitations of the claims as set forth in previous responses during the prosecution of this application.

Regarding the rejections of claims 17-29, 33-45, 49 and 50, the Examiner has offered the following statement to reject these claims:

“The claimed system would have been inherent to perform the method disclosed by Bush et al as stated above. Therefore, they are rejected under the same rationale.” Office Action, p. 4.

However, as is clear based on the discussion above, Bush fails to disclose or suggest several limitations of the claimed invention. Accordingly, Bush cannot anticipate claims 17-29, 33-45, 49 and 50.

CONCLUSION

In view of the foregoing, Applicants submit that claims 1-13, 17-29, 33-45, 49 and 50, all of the pending claims, are in condition for allowance. In the event that the application is not deemed in condition for allowance, the Examiner is invited to contact the undersigned in an effort to advance the prosecution of this application.

Respectfully submitted,



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